

50.(New) A system as set forth in Claim 43 further comprising means for capturing a laser scatter image of the gemstone with said electronic camera means.

51.(New) A system as set forth in Claim 47 further comprising means for capturing a culet image of the gemstone with said electronic camera means.

52.(New) A system as set forth in Claim 47 further comprising means for capturing a table facet image of the gemstone with said electronic camera means.

53.(New) A system as set forth in Claim 47 further comprising means for capturing a surface feature image of the gemstone with said electronic camera means.

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REMARKS

Applicant respectfully requests that the Examiner reconsider this application in the light of the foregoing amendments and the following remarks.

Claims 30-33 and 36-53 are currently pending in this application. Claims 34 and 35 are canceled and Claims 42-53 are being added. No new matter is added by the new claims. Written support for Claim 42 is found at page 8, line 30, to page 12, line 30. See also, Figures 3 and 4. Written support for Claim 43 is found at page 19, line 25, to page 20, line 12, and Figure 6. Written support for Claims 44 and 47 is found at page 22, line 22, to page 23, line 26, and Figures 7, 8, and 9. Written support for Claims 45, 46, and 48-53 is found at page 24, line 18, to page 28, line 25, and Figures 10A-10C.

I. 35 U.S.C. §102(b): Claims 34 and 35

The Examiner rejected Claims 34 and 35 under 35 U.S.C. §102(b). In making the rejection, the Examiner asserted that the subject matter of those claims was

anticipated by International Publication No. WO93/12496 (Ezzel et al.). Although Claims 34 and 35 have been canceled, new Claims 42 to 53 are presented in their place with this response. New Claims 42 to 53 are believed to be patentable over Ezzel et al. for the following reasons.

Ezzel et al. relates to a "computer imaging system for gemstones". More specifically, Ezzel et al. describes a "computerized trading system" for gemstones. The system includes a capture unit, a central unit, and a display unit. The capture unit includes a video camera 22, a computer processor 21, monitors 25 and 251, and a disk drive 27. The capture unit is configured to capture and store "images of gemstones". Other information relating to a gemstone, such as its color, weight, cut, clarity, price, etc. are input manually to the computer processor via the keyboard 23 and/or a mouse 231. Ezzel et al. indicates that the capture unit 20 may include an electronic scale 24 for measuring the weight of the gemstone. The images and the other data are read by the computer processor 21 and stored on the disk drive 27. Ezzel et al. also describes that the capture unit may include a label printer for printing a unique bar code label that is affixed to the container for each gemstone. The capture unit may also include a bar code reader for scanning the labels of all the gemstones in the inventory for verification of the accuracy and completeness of an order or for verification against the inventory data maintained by the computer processor.

Ezzel et al. does not describe what images of the gemstones are "captured" or even that more than one image of each gemstone is captured. Ezzel et al. neither describes nor suggests capturing multiple images of a gemstone so that different physical characteristics of the stone can be determined. Ezzel et al. does not describe or suggest analyzing the electronic signals from the video camera to provide data files containing information identifying at least two different physical characteristics of a gemstone. Indeed, it appears that the capture unit merely takes an electronic picture of a gemstone and stores it for later retrieval and display on a computer monitor or other display device

so that it can be viewed by a potential buyer. It is further noted, that gemstone characterizing information such as color, cut, clarity, etc. must be input manually to the Ezzel et al. capture unit.

In contrast, Applicant's claimed system as set forth in Claim 42 includes electronic data processor means which analyzes the electronic image signal generated by the electronic camera to provide data files containing information identifying at least two different physical characteristics of the gemstone.

Further, Applicant's claimed system as set forth in Claim 42 includes "means for comparing the identifying information of the viewed gemstone provided by said electronic data processor with the identifying information of a known gemstone retrieved from said data storage device so that the gemstone viewed by the electronic camera means can be accurately identified from the database of gemstone identifying information." Ezzel et al. does not describe or suggest a system in which a computer processor includes means for comparing the generated information to the stored information of a known gemstone retrieved from the data storage.

In view of the foregoing, the system described in Ezzel et al. does not anticipate or suggest Applicant's claimed system as set forth in Claim 42. Accordingly, Claim 42 is believed to be patentable over Ezzel et al.

Claim 43 is directed to the system of Claim 42 which also includes means for illuminating the gemstone and light control means for controlling the illumination of the gemstone. Ezzel et al. does not describe or suggest any comparable components. Applicant acknowledges that Ezzel et al. describes that the video camera 22 is mounted on a stand which permits adjustments in the intensity and filtering of one or more light sources used to illuminate the gemstone. However, there is no description of how such adjustments are implemented or how the light sources are operated. Therefore, Ezzel et al. does not anticipate or suggest Applicant's claimed system as set forth in Claim 43.

Claim 44 is directed to the system of Claim 43 which includes means for

displacing the gemstone relative to the electronic camera means and the electronic data processor means includes means for controlling the displacing means for capturing a profile image and color image of a gemstone. Ezzel et al. does not describe or suggest any comparable components. Applicant acknowledges that Ezzel et al. describes that the video camera 22 is mounted on a stand which permits adjustment of the distance between the video camera and the gemstone. However, there is no description of how such adjustments are implemented or how the stand is operated. Therefore, Ezzel et al. does not anticipate or suggest Applicant's claimed system as set forth in Claim 44.

Claims 45 to 53 are directed to the system of Claim 43, either directly or indirectly, and set forth additional features of Applicant's claimed system. For example, Claim 45 adds the feature of means for capturing multiple profile and color images of a gemstone. Claim 46 adds the feature of means for capturing a fluorescence image of the gemstone. Claim 47 adds the feature of means for capturing an image that characterizes the brilliance and scintillation properties of the gemstone. Claim 48 adds the feature of means for capturing a girdle image of the gemstone. Claim 49 adds the feature of means for capturing an image that characterizes the table and luster of the gemstone. Claim 50 adds the feature of means for capturing a laser scatter image of the gemstone. Claim 51 adds the feature of means for capturing a culet image of the gemstone and Claim 52 adds the feature of means for capturing a table facet image of the gemstone. Finally, Claim 53 adds the feature of capturing a surface feature image of the gemstone.

The benefit of capturing and storing two or more images of a gemstone is that a viewed gemstone can be more accurately identified because there are more characteristics to compare. This is a significant advance over the gem trading system described in Ezzel et al. which is effectively no more than an picture storage and retrieval system. The Applicant's claimed system has great value in the retail and wholesale gem markets where precious gemstones need to be accurately identified for tracking purposes and to prevent fraud. Ezzel et al. does not enable one skilled in the

art to make a gem information system such as that set forth in Claims 42 to 53. Nor does it provide any suggestion of how to go about making and using such a system. For all these reasons, Applicant submits that his claimed system as set forth in Claims 42 to 53 is patentable over the system described and shown in Ezzel et al.

## **II. Double Patenting**

The Examiner rejected Claims 30-33 and 36-41 under the judicially created doctrine of obviousness-type (nonstatutory) double patenting over Claims 1-29 of U.S. Patent No. 6,020,954 and Claims 1-52 of U.S. Patent No. 6,239,867. In making this rejection, the Examiner stated that the claims of the present application, if allowed, "would improperly extend the 'right to exclude' already granted in the patent." The Examiner went on to state: "The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. . ."

Applicant submits that this rejection is improper because under current U.S. patent law, a patent issuing on the present application cannot extend the exclusive rights granted with the earlier issued patents beyond the maximum enforceable term of the earlier issued patents. The basis for the nonstatutory double patenting rejection was effectively eliminated by the amendments to the patent statutes governing patent term of U.S. patents. This application and the two patents cited by the Examiner were filed after June 8, 1995. Therefore, the maximum terms of the patents, and any patent that issues from this application is twenty (20) years from the earliest effective filing date. See, 35 U.S.C. §154. U.S. Patent No. 6,239,867 claims the benefit of priority of the filing date of and contains a specific reference to U.S. Patent No. 6,020,954, May 28, 1998. Therefore, the maximum enforceable term of U.S. Patent No. 6,239,867 will end on May 28, 2018. The present application also claims the benefit of priority of the filing date of U.S. Patent No. 6,020,954 and contains a specific reference to that patent.

Application No. 09/701,195  
Docket No. 1005-AGGUS3

Examiner ROY M. PUNNOOSE  
Art Unit 2877

Therefore, the maximum enforceable term of a patent issuing from this application will also end on May 28, 2018. Thus, it should now be readily apparent that any patent issuing on the present application cannot and will not extend the exclusive rights granted with either of the two earlier issued patents. Accordingly, this rejection is improper and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that this application is in condition for allowance. Early and favorable reconsideration of the claimed subject matter is respectfully requested.

Respectfully submitted,  
DANN, DORFMAN, HERRELL AND SKILLMAN  
A Professional Corporation  
Attorneys for Applicant(s)

By Vincent T. Pace  
VINCENT T. PACE  
PTO Registration No. 31,049

Tel.: 215-563-4100  
Fax: 215-563-4044  
e-mail: [vpac@ddhs.com](mailto:vpac@ddhs.com)